

Claim 2 has been canceled. Claims 1 and 3-8 are still at issue and are present for examination.

Applicants' arguments filed on 8/30/10, have been fully considered and are deemed to be persuasive to overcome some of the rejections previously applied. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn.

The disclosure is objected to because of the following informalities: the specification abbreviation for the *Porteresia coarctata* myo-inositol 1-phosphate synthase gene should be consistent with the abbreviation for this gene used within the claims. Since applicants have changed this in the claims it should be changed throughout the specification as well.

Appropriate correction is required.

Claim 6 is objected to because of the following informalities: the abbreviation for the *Porteresia coarctata* myo-inositol 1-phosphate synthase gene product should be consistent with the abbreviation for this protein used within the rest of the claims. Appropriate correction is required.

Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 is confusing in the recitation of "introduced into the host strain E.coli BL-21(DE 3) by culturing ..." as culturing is not a means of introducing a plasmid into a host strain. It is suggested that the claim be amended to recite "introduced into the host strain E.coli BL-21(DE 3) and said transformed host strain is cultured to express the PcIN01 gene product".

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1 and 3-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Raychaudhuri et al. (1996) in view of Yoshida et al. The rejection is explained in the previous Office Action.

Applicants arguments in response to the instant rejection are extremely unclear and confusing. The examiner does not

understand what applicants argument actually is. Applicants recite the relevant law regarding obviousness in the final paragraph on page 5 of their remarks, however it is not clear how this is related to the instant rejection as the comments on page 6 do not explain how the rejection renders the prior art unsatisfactory for its intended purpose or requires a substantial reconstruction and redesign of the elements of the primary reference. It is noted that the rejection does NOT in fact suggest modifying the *Oryza sativa* myo-inositol 1-phosphate synthase gene to produce the *Porteresia coarctata* myo-inositol 1-phosphate synthase gene but instead suggests isolating the gene encoding the *Porteresia coarctata* myo-inositol 1-phosphate synthase protein disclosed by Raychaudhuri using the methods of Yoshida. Doing this would not require modifying the structure of the sequence encoding the *Porteresia coarctata* myo-inositol 1-phosphate synthase protein at all but merely requires isolating it from the genome of *Porteresia coarctata*. Since Raychaudhuri et al. disclose the protein and disclose its salt tolerant properties, a skilled artisan would understand that the genome of *Porteresia coarctata* must encode a gene encoding this protein having the disclosed salt tolerant properties. Furthermore, a skilled artisan would reasonably expect the methods of isolating the *Oryza sativa* myo-inositol 1-phosphate

synthase gene taught by Yoshida et al. to be applicable to isolating the gene encoding the *Porteresia coarctata* myo-inositol 1-phosphate synthase protein disclosed by Raychaudhuri et al. as a skilled artisan would understand that these methods are generally applicable to isolating any gene encoding a protein of interest and do not depend on any knowledge of the structure of the gene to be isolated. The sequence of SEQ ID NO:1 is simply an inherent property of the nucleic acid encoding the protein disclosed by Raychaudhuri made obvious by the combined disclosures of Raychaudhuri et al. and Yoshida et al.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rebecca E. Prouty whose telephone number is 571-272-0937. The examiner can normally be reached on Tuesday-Friday from 8 AM to 5 PM. The examiner can also be reached on alternate Mondays

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Mondesi, can be reached at (571) 272-0956. The fax phone number for this Group is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Rebecca Prouty/  
Primary Examiner  
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